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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,771	02/18/2004	Harald Schaty	A-10035	1637
28368 7590 09/19/2008 THE BLACK & DECKER CORPORATION 701 EAST JOPPA ROAD, TW199 TOWSON, MD 21286				
EXAMINER				
CHEVALIER, ALICIA ANN				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
09/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,771

Applicant(s)

SCHATY, HARALD

Examiner

ALICIA CHEVALIER

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

RESPONSE TO AMENDMENT

1. Claims 1-4 and 7-20 are pending in the application, claims 14-20 are withdrawn from consideration. Claims 5 and 6 have been cancelled.
2. Amendments to the claims, filed on June 9, 2008, have been entered in the above-identified application.

Election/Restrictions

3. Newly submitted claims 14-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Inventions of the original claims and the newly submitted claims are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as cling wrap and the inventions are deemed patentably distinct because there is nothing of record to show them to be obvious variants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

5. Claims 1-4 and 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al. (WO 01/02316) with English translation (U.S. Patent No. 6,863,956).

Nakajima discloses an object (*title*) consisting of a single layer of synthetic thermoplastic adhesive material (*col. 5, lines 33-37*). The object has a contact surface that is rough, where Rz is in a range from 40 μ to 100 μ , more specifically 55 μ to 70 μ (*col. 14, lines 33-35*). The rough adhesive material is deemed to contact surfaces occupy the entirety of the opposite sides of the object (*figure 1*).

Nakajima fails to disclose that the adhesive device is disk-shaped/ annulus with a central hole.

It would have been an obvious matter of design choice to change the shape of adhesive, since a modification would have involved a mere change in size of the adhesive. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). Furthermore, one of ordinary skill in the art would have been motivated to change shape in order adapt the adhesive to different surfaces. As evidenced by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176 adhesives can be made in to disk shapes to suit different user needs.

The limitation “for use as an intermediate between parts” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an arithmetic mean roughness Ra lines in the range from 6 μ to 25 μ , more specifically 10 μ to 15 μ , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. MPEP 2144.05 (II).

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments in the response filed June 9, 2008 regarding the 35 U.S.C. 103(a) rejection over Nakajima of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Nakajima is directed to an interlayer for laminated glass and there is no indication that a hole would be desirable in a laminated glass interlayer and the examiner has provided no evidence that a hole in glass interlayers is known or desirable.

The interlayer of Nakajima is just an adhesive. As evidenced by U.S. Patent No. 5,552,177, U.S. Patent No. 5,735,889, and U.S. Patent No. 5,792,176 adhesives can be made in to disk shapes to suit different user needs. Further examples of “interlayer” adhesives safety glass with holes are found in U.S. Patent Nos. 6,503,357 and 4,805,541. Therefore, since adhesive are know to have holes and come in different shapes and sizes, it would have been an

obvious matter of design choice to change the shape of adhesive, since a modification would have involved a mere change in size of the adhesive.

Applicant argues Nakajima doesn't disclose the arithmetic mean rugosity of claim 8 and that it is not a recognized result-effective variable.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. Applicant has not shown unexpected results.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/
Primary Examiner, Art Unit 1794
9/19/2008